

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WELLS OBRECHT

Appeal No. 2001-2120
Application No. 08/900,360

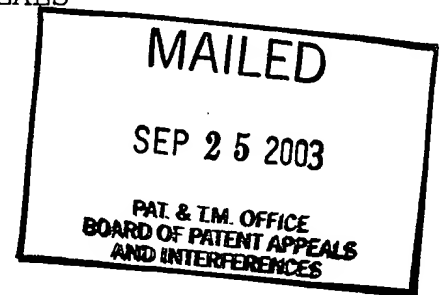
HEARD: August 21, 2003

Before RUGGIERO, BARRY, and LEVY, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 1-20, which are all of the claims pending in the present application.

The disclosed invention relates to a method and system for purchasing goods from a seller in which a central computer receives a request from a buyer with a plurality of criteria relating to the goods and services. Based on the submitted criteria, sellers from a predetermined group are selected and the buyer's request is transmitted to the selected sellers. Responses received from the



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selected sellers are compiled and the sellers are ranked based on the compiled information and the criteria set by the buyer.

Claim 1 is illustrative of the invention and reads as follows:

1. A method for purchasing goods or services from a seller by a buyer comprising:

(a) receiving a request from a buyer for goods or services with a predetermined plurality of criteria related to the goods or services;

(b) selecting at least one seller from a predetermined group of sellers of the goods or services based on the received predetermined plurality of criteria;

(c) transmitting the request of the buyer to the selected at least one seller of the goods or services;

(d) receiving, within a predetermined time interval, responses from the at least one seller to the request;

(e) compiling information provided in the responses received from at least one seller within the predetermined time interval;

(f) ranking the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking; and

(g) providing the compiled responses of the selected sellers for access by the buyer.

The Examiner relies on the following prior art;

Salmon et al. (Salmon)

5,592,375

Jan. 07, 1997
(filed Mar. 11, 1994)

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Source Interactive Software (Reference U)¹, "INTERACTIVE BUYERS NET: Buyer/Seller Interactive Software Inc. acquired, new software introduced," Business Wire (August 22, 1995).

Source Interactive Software (Reference V), "IBNL announces signing of more than \$8 billion in buying power," Business Wire, p11151062 (November 15, 1996).

Source Interactive Software (Reference W), "IBNL declares 20 percent stock dividend; SOURCE Interactive Software systems operational," Business Wire, p12141036 (December 14, 1995).

Source Interactive Software (Reference X), "IBNL FORGES INTO THE FUTURE OF BUYING AND SELLING WITH SOURCE INTERACTIVE SOFTWARE," PR Newswire, p110LAW034 (January 10, 1996).

Source Interactive Software [Reference U(2)], "IBNL restructures capitalization; adds proven management; releases its new 'Virtual Source' software," Business wire p11120218 (November 12, 1996).

¹ References U, V, W, X, U(2), and V(2) are a series of documents related to a product identified in the documents as Source Interactive Software. The Examiner has used the alphabetic designations U, V, W, X, U(2), and V(2) to identify these documents and distinguish them from each other. Since both Appellant and the Examiner refer to these documents by this alphabetic designation, we will do so also in this decision to maintain consistency.

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Source Interactive Software [Reference V(2)], "Vsource (The Vsource Story)" retrieved from the Internet [URL:<http://www.vsource.net>] (February 7, 2000).

Claims 1-20, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the Source Interactive Source documents U, V, W, X, U(2), and V(2), collectively, in view of Salmon.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, the arguments in support of the rejection and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the

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particular art would not have suggested to one of ordinary skill in the art the invention as set forth in claims 1-20. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part

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of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

At the outset, we note that Appellant, during the course of prosecution of this application, has filed several declarations under 37 CFR § 1.131 in attempts to swear behind references applied by the Examiner. The initial declaration under 37 CFR § 1.131 filed December 9, 1999 (Paper No. 9) submitted facts and evidence in support of the assertion that reduction to practice of the invention occurred before February 22, 1996, which was the effective date of the applied Giovannoli reference (U.S. Patent No. 5,758,328), or, alternatively, that conception occurred before the effective date coupled with diligence to a later reduction to practice. Included in the evidence submitted was an article (Exhibit A), written by Appellant, entitled "High Level Design Automotive Live Market Exchange System."

The Examiner, on consideration of the facts and evidence presented in the declaration of December 9, 1999, deemed the declaration sufficient to overcome the Giovannoli reference (page 2 of the Office action mailed February 17, 2000, Paper No. 11). A new 35 U.S.C. § 103(a) rejection was then made by the Examiner in which the document collection [References U, V, W, X, U(2), and

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V(2)] related to the Source Interactive Software product was applied as a reference in combination with Salmon. In response to this newly applied reference, Appellant filed a supplemental declaration under 37 CFR § 1.131 on June 14, 2000 (Paper No. 14) in an attempt to swear behind the January 10, 1996 publication date of Reference X.

Initially, after reviewing Appellant's 37 CFR § 1.131 declarations and the collection of Source Interactive Software documents applied as a reference by the Examiner, we agree with Appellant that January 10, 1996, the publication date for Reference X, is the critical date for the Source Interactive Software document collection. As indicated by the Examiner's statement of the grounds of rejection (Answer, page 4, which incorporates the Office action mailed February 17, 2000, Paper No. 11), Reference X is the only one of the Source Interactive Software documents which actually describes what the Examiner is alleging as corresponding to several of the limitations in the appealed claims. Although the Examiner asserts (Answer, page 6) that it is the earliest date of the collective Source Interactive Software product description documents, i.e., Reference U with a publication date of August 22, 1995, that must be sworn behind, we find no evidence provided by the Examiner to support such a conclusion. In our view, References

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U, V, and W, at best, establish that the company which produced the product described in Reference X, existed as early as August 22, 1995, the publication date of Reference U. It is our opinion, however, that, from the information provided in the earlier dated References U, V, and W, any conclusion that the product described in those references is the same as the one described in Reference X would be based on unwarranted and unsupported speculation.

With the above in mind, and considering the January 10, 1996 date of reference X as the critical date to be overcome, we find that the declarations filed December 9, 1999 and June 14, 2000 are sufficient to antedate the publication date of Reference X. We would point out that, in considering the merits of these declarations, it is important to recognize that they must be read together and not in isolation. As previously discussed, the Examiner considered the December 9, 1999 declaration sufficient to overcome the February 22, 1996 date of the previously applied Giovannoli reference. In our view, the facts alleged and the evidence submitted (including Exhibit A) in the December 9, 1999 declaration when considered together with the facts set forth in the supplemental declaration of June 14, 2000 are sufficient to overcome the January 10, 1996 publication date of reference X, which is mere six weeks earlier in time than the February 22, 1996

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date already considered to be overcome by the December 9, 1999 declaration.

Aside from questioning (Answer, page 21) the intended meaning of the word "from" in the phrase ". . . [l]ess than three weeks from the date of January 10, 1996", the Examiner has not indicated what has been found deficient in the December 9, 1999 and June 14, 2000 declarations. From our review of the declarations in question, it is apparent to us that, regardless of the starting point in time designated by the word "from", the alleged facts and supporting evidence in the December 9, 1999 and June 14, 2000 declarations are sufficient to overcome the January 10, 1996 date of Reference X.

Further evidence of record which supports Appellant's position as to the effectiveness of the Rule 131 declarations is the further supplemental declaration filed July 3, 2001. This declaration was filed in response to the Examiner's comments in the Answer suggesting that Appellant need only overcome the December 14, 1995 date of Reference W, describing an Internet embodiment of the Source Interactive Software system, rather than the August 22, 1995 date of the earlier Reference U. The Examiner, in clarifying communications submitted in response to a remand from the Board (Paper No. 31, mailed August 23, 2002, and Paper No. 34, mailed

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November 29, 2002), entered the July 3, 2001 declaration but, aside from an unsupported conclusion that no evidence was submitted, has not indicated with any particularity why the July 3, 2001 declaration when considered with the previously submitted December 9, 1999 and June 14, 2000 declarations are deficient. We would also point out that the July 3, 2001 declaration does not contain the ". . . from the date of . . ." language that the Examiner considered to be ambiguous in the June 14, 2000 declaration.

Given the above factual situation presented to us on the record, and finding no persuasive arguments to the contrary presented with any particularity by the Examiner, we find the facts and evidence presented in the declaration under 37 CFR § 1.131 filed December 9, 1999 and supplemented by the declarations filed June 14, 2000 and July 3, 2001 sufficient to antedate the critical January 10, 1996 publication date of Reference X.

Turning to a consideration of the Salmon reference, the sole remaining valid reference applied against the appealed claims, we find that Salmon does not teach or suggest all of the limitations of appealed independent claims 1, 10, and 19. In Salmon, seller information is prestored in the system database which can be accessed by a buyer with a particular request. The system of Salmon will search the database and compile and present information

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to the buyer including a ranking of products which meet a buyer's submitted criteria. We find no teaching, however, in Salmon of any receipt of sellers' responses to a buyer's request, let alone any compilation of any such responses to present the responses in an ordered form to the buyer as claimed. In view of the above discussion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103(a) rejection of independent claims 1, 10, and 19, as well as claims 2-9, 11-18, and 20 dependent thereon, is not sustained.

As a final commentary, we take note of the fact that Appellant filed a petition on July 3, 2001 under 37 CFR § 1.181(a) taking issue with the Examiner's position in the Answer that separate arguments for patentability of the appealed claims were not presented and therefore ". . . claims 1-20 stand or fall together." In a decision by John J. Love, Director of Technology Center 2100, mailed March 27, 2002, the petition was denied indicating that the issue of the grouping of claims is an appealable issue and not proper subject matter for petition. We would point out, as also discussed in the decision on the petition, that, despite the Examiner's position on the grouping of claims, the Examiner did in

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fact treat all claims that were separately argued in the Brief. In any case, the issue of the grouping of claims becomes moot in view of our decision in this appeal.

In summary, we have not sustained the Examiner's 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Accordingly, the decision of the Examiner rejecting claims 1-20 is reversed.

REVERSED

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge

~~LANCE LEONARD BARRY~~
Administrative Patent Judge

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STUART S. LEVY
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